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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte Craig D. Church

Appeal 2008-6282
Application 10/774,372
Technology Center 3600

Decided: ¹ March 17, 2009

Before HUBERT C. LORIN, DAVID B. WALKER, and
BIBHU R. MOHANTY, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

STATEMENT OF THE CASE

Craig D. Church (Appellant) seeks our review under 35 U.S.C. § 134 of the final rejection of claims 1, 4, 7, 10-12, 14-21, 23-26, and 42-49. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We REVERSE.²

THE INVENTION

The invention is a system for and a method of requesting and receiving location information for an item on a portable device. (Specification [0003].) The portable device determines whether the portable device is inside a store. (Specification [0034].) If the portable device is in a store, the portable device displays a main menu, which has a list of stores. (Specification [0036].) After the user selects a store from the list, the portable device displays a store menu, which has a list of store items. *Id.* The user can then select one or more items and the portable device then displays the location of the items in the store. *Id.*

Claim 1, reproduced below, is illustrative of the subject matter on appeal.

1. A method comprising:
determining whether a portable device is or
is not located within a first site;

² Our decision will make reference to the Appellant's Appeal Brief ("App. Br.," filed Oct. 9, 2007) and Reply Brief ("Reply Br.," filed Feb. 26, 2008), and the Examiner's Answer ("Answer," mailed Dec. 26, 2007).

wherein when the portable device is located within the first site:

sending a menu of items located at the first site to the portable device for displaying to a user,

receiving from the portable device, a selection by the user of at least one item from the menu of items located at the first site, and

sending location information regarding the at least one item selected from the menu of items at the first site to the portable device for displaying to the user; and

wherein when the portable device is not located within the first site:

sending to the portable device a menu of sites located within a vicinity of the portable device for displaying to the user, and

receiving from the portable device a selection of a second site from the menu of sites by the user.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Fano	US 6,317,718 B1	Nov. 13, 2001
Ludtke	US 2002/0138372 A1	Sep. 26, 2002
Perkowski	US 2002/0194081 A1	Dec. 19, 2002
Malackowski	US 2003/0027555 A1	Feb. 6, 2003
Swartz	US 6,937,998 B1	Aug. 30, 2005

The following rejections are before us for review:

1. Claims 1, 4, 7, 11-12, 18, 20-21, 23-24, and 42-49 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Fano in view of Swartz.

2. Claims 10, 14-15, 19, and 25 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Fano in view of Swartz and Perkowski.
3. Claim 16 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Fano in view of Swartz and Ludtke.
4. Claims 17 and 26 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Fano in view of Swartz and Malackowski.

ISSUES

The first issue before us is whether the Appellant has shown that the Examiner erred in rejecting claims 1, 4, 7, 11, 42, and 48-49 under 35 U.S.C. § 103(a) as being unpatentable over Fano in view of Swartz. The issue turns on whether one of ordinary skill in the art would have been led by the combination of Fano in view of Swartz to the step of determining whether a portable device is or is not located within a first site. The rejection of dependent claim 10 also turns on this issue.

The second issue before us is whether the Appellant has shown that the Examiner erred in rejecting claims 12, 18, 20, 21, 23, 24, and 44-47 under 35 U.S.C. § 103(a) as being unpatentable over Fano in view of Swartz. The issue turns on whether one of ordinary skill in the art would have been led by the combination of Fano in view of Swartz to an apparatus comprising processing logic which determines whether a portable device is or is not located within a first site. The rejections of dependent claims 14-17, 19, 25, and 26 also turn on this issue.

FINDINGS OF FACT

We find that the following enumerated findings of fact (FF) are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

Claim construction

1. Claim 1 recites a method comprising the step of “determining whether a portable device is or is not located within a first site.”
2. Claim 12 recites a portable device including processing logic which “determines whether the portable device is or is not located within a first site.”
3. Claim 20 recites a server having a first processing logic which “determines whether a portable device is or is not located within a first site.”
4. Claim 45 recites a tangible computer-readable medium having a plurality of instructions for at least one processor, which causes the processor to “determine[e] whether a portable device is or is not located within a first site.”
5. Claim 48 recites a method comprising the step of “determining whether a portable device is or is not located within a first site.”
6. The Specification does not provide a definition for “site”.
7. The ordinary and customary meaning of “site” is “1 a: the spatial location of an actual or planned structure or set of structures (as a building, town, or monuments) b: a space of ground occupied or to

be occupied by a building.” (See *Merriam-Webster’s Collegiate Dictionary* 1097 (10th Ed. 1998.)(Second entry for “site.”)

8. The Specification does not provide a definition for “within”.
9. The ordinary and customary meaning of “within” is “used as a function word to indicate enclosure or containment.” (See *Merriam-Webster’s Collegiate Dictionary* 1359 (10th Ed. 1998.)(Entry for “within.”)

The scope and content of the prior art

Fano

10. Fano describes a personal digital assistant with a system that alerts a shopper to merchandise of previously specified categories in the surrounding stores. (Col. 2, ll. 39-51.)
11. Column 47, line 58 – column 48, line 26 of Fano states:

To address the need of many shoppers to visit malls or shop generally without a particular destination in mind, FIG. 27 illustrates a display in accordance with a preferred embodiment of the invention. The display operates in a browse mode for use by shoppers as they stroll through the mall. In browse mode the system suggests items of interest for sale in stores currently closest to the shopper. An item is considered to be of interest if it matches the categories entered in the goals screen. If there are no items of interest, the general type of merchandise sold at that store is displayed, rather than specific items. As the shopper strolls a map displays his or her precise current location in the mall. If an item displayed is selected by the shopper while browsing, the system alerts the shopper to the local retailer offering the same

product for the lowest price. This search is restricted to the local mall, as that is the assumed radius the shopper is willing to travel.

12. The system uses a GPS receiver to determine the user's location. (Col. 47 ll. 22-24.)
13. The accuracy of smaller, inexpensive receiver is limited to approximately 75-100 feet, which is all that is necessary to identify accurately the immediately surrounding stores. (Col. 47, ll. 26-29.)

Swartz

14. Swartz describes using a portable hand held terminal to find suppliers of products and services based on a customer's proximity to the suppliers and the customer's shopping profile. (Col. 2, ll. 46-56.)
15. Column 9, lines 47-58 states:

If a user selects the clothing icon 104, either by touching the icon 104 with a stylus, or by maneuvering a pointer on the icon 104 by use of a joystick, mouse, voice, or analogous pointing control device and by thereupon actuating the device, a first cascading menu 108 having store icons 110, 112, 114 bearing the identities of clothing stores in the mall appears on the terminal screen. By selecting one of the store icons 114, a second cascading menu 116 having information icons 118, 120, 122 bearing such labels as location, hours and sales appears on the screen. By selecting one of the information icons 118, 120, 122, the requested information will appear on the screen.

Perkowski

16. Perkowski describes allowing a user at a kiosk in a shopping mall to email selected product information to a home account. (Perkowski [0915].)
17. Perkowski describes using a touch screen to display product information. (Perkowski [0037-0038].)

Ludtke

18. Ludtke describes a user using a PDA to select a product on a list by writing a product description using a stylus or touch screen. (Ludtke [0055].)

Malackowski

19. Malackowski describes a system which allows a user on a cellular phone to retrieve product information by saying the product name. (Malackowski [0017]-[0018].)

Any differences between the claimed subject matter and the prior art

20. Fano does not describe determining whether the portable device is or is not within the first site.

The level of skill in the art

21. Neither the Examiner nor the Appellants have addressed the level of ordinary skill in the pertinent art of data communications. We will therefore consider the cited prior art as representative of the level of ordinary skill in the art. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (“[T]he absence of specific findings on the level of skill in the art does not give rise to reversible error ‘where the prior art itself reflects an appropriate level and a need for testimony is not shown’”) (“[T]he absence of

specific findings on the level of skill in the art does not give rise to reversible error ‘where the prior art itself reflects an appropriate level and a need for testimony is not shown’”) (Quoting *Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755 F.2d 158, 163 (Fed. Cir. 1985)).

Secondary considerations

22. There is no evidence on record of secondary considerations of non-obviousness for our consideration

PRINCIPLES OF LAW

Claim Construction

During examination of a patent application, a pending claim is given the broadest reasonable construction consistent with the specification and should be read in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1369 (Fed. Cir. 2004).

[W]e look to the specification to see if it provides a definition for claim terms, but otherwise apply a broad interpretation. As this court has discussed, this methodology produces claims with only justifiable breadth. *In re Yamamoto*, 740 F.2d 1569, 1571 (Fed. Cir. 1984). Further, as applicants may amend claims to narrow their scope, a broad construction during prosecution creates no unfairness to the applicant or patentee. *Am. Acad.*, 367 F.3d at 1364.

In re ICON Health and Fitness, Inc., 496 F.3d 1374, 1379 (Fed. Cir. 2007). Limitations appearing in the specification but not recited in the claim are not read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed. Cir. 2003).

Obviousness

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). See also *KSR*, 127 S.Ct. at 1734 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”) The Court in *Graham* further noted that evidence of secondary considerations “might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.” 383 U.S. at 17-18.

ANALYSIS

The rejection of method claims 1, 4, 7, 11, 42, and 48-49 under 35 U.S.C. § 103(a) over Fano in view of Swartz.

The Appellant argues that the combination of Fano and Swartz does not describe the claimed invention since Fano does not describe the step of

determining whether a portable device is or is not located *within* a first site. (App. Br. 14-15.) The Appellant contends that Fano only describes identifying nearby stores and immediately surrounding stores and not whether the device is *within* the store. (App. Br. 15.) The Appellant state that determining the closest, nearby or immediately surrounding stores is different than determining when the device is or is not located within the first site. (Reply Br. 6.)

The Examiner contends that the first site is a store closest to the user containing items of interest and that the claimed determining step is analogous to determining when the device is *within range* of the store having items of interest in Fano. (Answer 12.) The Examiner states, “To be clear on the record, the first site is not merely just the immediate or nearby stores; rather, the first site as found in Fano is a nearby or immediate store that contains items of interest.” (Answer 12.)

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. *See In re Rijckaert*, 9 F.3d 1531, 1532 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. *See In re Lintner*, 9 F.2d 1013, 1016 (CCPA 1972). “[T]he Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion.” *In re Lee*, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).

Claim 1 recites a method including the step of “determining whether a portable device is or is not located within a first site.” (FF 1.) Claim 48 also recites the same limitation. (FF 5.) “Analysis begins with a key legal question -- *what is the invention claimed?* Courts are required to view the claimed invention *as a whole*. 35 U.S.C. § 103. Claim interpretation, in light of the specification, claim language, other claims, and prosecution history, is a matter of law and will normally control the remainder of the decisional process.” *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561 (Fed. Cir. 1987). The customary and ordinary meaning of “site” is the spatial location of an actual or planned structure or set of structures (as a building, town, or monuments) or a space of ground occupied or to be occupied by a building. (FF 6-7.) The customary and ordinary meaning of “within” is used as a function word to indicate enclosure or containment. (FF 8-9.) Therefore, claims 1 and 48 require the step of determining whether a portable device is or is not enclosed or contained in a first location occupied or to be occupied by a building.

Fano describes using a GPS receiver to determine the location of the user (FF 12). The GPS receiver is accurate in a range of 75-100 feet. (FF 13). Further, Fano describes identifying stores currently closest to a shopper and that some stores contain items of interest to the shopper. (FF 11.)

We find that Fano does not describe determining whether the device is or is not enclosed or contained in a nearby or immediate store. (FF 20.) We find that identifying a store containing items of interest currently closest to a shopper is not expressly or inherently determining whether a portable device is or is not located within a store. The accuracy of the GPS receiver

is limited to 75-100 feet (FF 13) and it is not inherent that the receiver would be located within the closest store.

Swartz also does not describe and the Examiner did not cite Swartz to teach determining whether a portable device is or is not located within a store. Further, the Examiner does not provide any explanation as to why one of ordinary skill in the art would have been led by Fano and Swartz to the step of determining whether the portable device is or is not located within the first site besides asserting that Fano describes the limitation.

We find that the Examiner has failed to present a prima facie case of obviousness, and therefore, we find that the Appellant has shown that the Examiner erred in rejecting claim 1. Accordingly, the rejection of claim 1 is reversed. Claims 4, 7, 11, and 42 depend from claim 1 and claim 49 depends from claim 48. The rejections of these claims are likewise reversed.

The rejection of manufacture claims 12, 18, 20, 21, 23, 24, and 44-47 under 35 U.S.C. § 103(a) over Fano in view of Swartz.

Like claim 1, claims 12, 20, and 45 were also rejected under 35 U.S.C. § 103(a) as being unpatentable over Fano in view of Swartz using the same rationale. (Answer 4.) The Appellant again argues with respect to each claim that the device in Fano does not determine whether the portable device is or is not within the first site. *See* App. Br. 19, 22, and 24-25.

Claim 12 recites a portable device comprising a processing device which “determines whether the portable device is or is not located within a first site.” (FF 2.) Claim 20 recites a system with similar processing logic (FF 3), and claim 45 recites a computer-readable medium similar processing logic (FF 4).

For the reasons discussed above, we find that Fano and Swartz would not lead one of ordinary skill in the art to an apparatus with a processing logic that determines whether the portable device is or is not within the first site. Therefore, the Appellant has shown that the Examiner erred in rejecting claims 12, 20 and 45 and accordingly, the rejection of claims 12, 20 and 45 is reversed.

Claims 18 and 43 depend from claim 12. Claims 21, 23, 24, and 44 depend from claim 20, and claims 46 and 47 depend from claim 45. The rejection of these claims is likewise reversed.

The rejection of claims 10, 14, 15, 19, and 25 under 35 U.S.C. § 103(a) over Fano in view of Swartz and Perkowski.

Claims 10, 14, 15, 19, and 25 were rejected under 35 U.S.C. § 103(a) as unpatentable over Fano, Swartz and Perkowski. Claim 10 depends from claim 1. Claims 14, 15, and 19 depend from claim 12. Claim 25 depends from claim 20. The Examiner cited Perkowski to teach providing an option of having results sent via e-mail and using a touch screen with an electronic pen, a stylus, or a finger to select an item on a display. (Answer 8). The Examiner has not provided any additional reasons why Fano, Swartz and Perkowski would lead one of ordinary skill in the art to the limitations of claims 1, 12, and 20 discussed above besides contending that Fano describes these limitations. For the same reasons, we will not sustain the rejection of claims 10, 14, 15, 19, and 25 over the cited prior art.

The rejection of claim 16 under 35 U.S.C. § 103(a) over Fano in view of Swartz and Ludtke.

Claim 16 was rejected under 35 U.S.C. § 103(a) as unpatentable over Fano, Swartz and Ludtke. Claim 16 depends upon claim 12. The Examiner cited Ludtke to teach using an electronic pen, a stylus, or a finger to write an item name on a touch screen. (Answer 9.) The Examiner has not provided any additional reasons why Fano, Swartz and Ludtke would lead one of ordinary skill in the art to the limitation of claim 12 discussed above besides contending that Fano describes this limitation. For the same reasons, we will not sustain the rejection of claim 16 over the cited prior art.

The rejection of claims 17 and 26 under 35 U.S.C. § 103(a) over Fano in view of Swartz and Malackowski.

Claims 17 and 26 were rejected under 35 U.S.C. § 103(a) as unpatentable over Fano, Swartz and Malackowski. Claims 17 and 26 depend upon claims 12 and 20 respectively. The Examiner cited Malackowski to teach the user speaking the item name to select an item. (Answer 10.) The Examiner has not provided any additional reasons why Fano, Swartz and Malackowski would lead one of ordinary skill in the art to the limitations of claims 12 and 20 discussed above besides contending that Fano describes these limitations. For the same reasons, we will not sustain the rejection of claims 17 and 26 over the cited prior art.

CONCLUSIONS OF LAW

We conclude that the Appellant has shown that the Examiner erred in rejecting:

claims 1, 4, 7, 11-12, 18, 20-21, 23-24, and 42-49 under 35 U.S.C. § 103(a) as being unpatentable over Fano in view of Swartz;

claims 10, 14-15, 19, and 25 under 35 U.S.C. § 103(a) as being unpatentable over Fano in view of Swartz and Perkowski;

claim 16 under 35 U.S.C. § 103(a) as being unpatentable over Fano in view of Swartz and Ludtke; and

claims 17 and 26 under 35 U.S.C. § 103(a) as being unpatentable over Fano in view of Swartz and Malackowski.

DECISION

The decision of the Examiner to reject claims 1, 4, 7, 10-12, 14-21, 23-26, and 42-49 is reversed.

REVERSED

JRG

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